

REMARKS

Claims 37-72 were pending in the Application. Claims 37-45, 47-57, 59-69 and 71-72 were rejected under 35 U.S.C. §102(b). Claims 37-72 were rejected under 35 U.S.C. §103(a). Claims 37-72 were rejected under the judiciary created doctrine of non-statutory double patenting. Applicants respectfully traverse the rejections and respectfully request that the Examiner reconsider and withdraw all outstanding rejections.

I. REJECTIONS UNDER 35 U.S.C. §102(b):

The Office Action has rejected claims 37-45, 47-57, 59-69 and 71-72 under 35 U.S.C. §102(b) as being anticipated by Luciw et al. (U.S. Patent No. 5,390,281) (hereinafter "Luciw"). Applicants respectfully traverse the rejections and respectfully request that the Examiner reconsider and withdraw all outstanding rejections. As the Examiner is aware, each and every element must be taught within the cited prior art reference to support a §102 rejection.

Luciw does not disclose "exercising a *predictive widget* to *supply a data entry for a defined data field*" as recited in claims 37, 49 and 61. Luciw discloses that "if SO(1) was 'map' and a user starts to write 'Czechoslovakia', the system might self delimit after every letter and decide at 'Czech' that a user was requesting a map of Czechoslovakia." See Column 10, Line 68 - Column 11, Line 3. As interpreted by the Applicants, Luciw discloses what is commonly referred to as QuickFill which uses an alphabetized list of prior entries. Applicants respectfully direct the Examiner's attention to pages 18-19 of the Specification which discusses QuickFill. QuickFill is not a *predictive widget*. Furthermore, Luciw discloses that "In FIG. 2, a user has entered 'ISAAC 10AM TUESDAY' in note N(1)." See Column 16, Lines 54-55. Luciw further discloses that "assuming the user then pauses, the process is delimited and the SO set is *compared against the task templates*. Since there are four task templates having <PERSON> (Scheduling, Mailing, Faxing, and Calling), a meaningful observation has been detected. Next, step 130 enumerates all possible intents (there are four of them) and calculates their relative weights." See Column 16, Lines 61-67. As interpreted by the Applicants, Luciw determines where the data, e.g., "Isaac", "10AM" "Tuesday", should be inserted. That is, Luciw determines which *particular template the data should be inserted* and not supplying

a data entry for a defined data field. Furthermore, Luciw discloses that "step 198 can ask the user where the meeting is to be held. Or, step 198 *can default to the last place that the user met Isaac.*" See Column 17, Lines 15-18. As interpreted by the Applicants, Luciw simply discloses defaulting to the last entry entered which is not a predictive method of the user's choice. Therefore, Luciw does not disclose "exercising a *predictive widget to supply a data entry for a defined data field*" as recited in claims 37, 49 and 61.

Luciw does not disclose "*capturing user entries of data into a defined field; storing captured user entries in a predictive list of data entries for the defined data field; and exercising a predictive widget to supply one of a predictive default and a predictive fill from the predictive list as a data entry for the defined data field*" as recited in claims 48, 60 and 72. Luciw discloses that "as the CPU senses the position and movement of the stylus, it generates a corresponding image on the screen to create the illusion that the stylus is drawing the image directly upon the screen, i.e. that the stylus is 'inking' an image on the screen. With suitable recognition software, text and numeric information can also be entered into the pen-based computer system in a similar fashion." See Column 2, Lines 28-34. As interpreted by the Applicants, Luciw simply discloses a computer system that allows the user to input information and generate images on the screen via a stylus. Allowing a user to input information and generate images on the screen via a stylus is not *capturing user entries of data into a data field* nor is it *storing those captured user entries in a predictive list of data entries*. Furthermore, Luciw discloses that "if PPLAN(i) calls for DAY, and no day is provided by the SO set 100, then DAY may default to the current day." See Column 14, Lines 36-38. As interpreted by the Applicants, Luciw simply discloses defaulting to the current day if no entry was provided for the particular day. Defaulting to the current day is not *supplying one of a predictive default and a predictive fill from the predictive list as a data entry*.

For at least the above reasons, claims 37, 48, 49, 60, 61 and 72 are not anticipated by Luciw. Claims 38-47, 50-59 and 62-71 each recite combinations of features including the above combinations, and thus are not anticipated for at least the above reasons as well. Claims 38-47, 50-59 and 62-71 recite additional features which, in combination with the features of the claims upon which they depend, are not anticipated by Luciw.

For example, Luciw does not disclose "*storing a predictive list and selecting a predictive default entry from the predictive list based on a predetermined algorithm*" as recited in claims 39, 51 and 63 and similarly in claims 41, 42, 53, 54, 65 and 66. Luciw discloses that "in a first step 130 all possible *user intents are enumerated from the task templates*. In a second step 132, the possible user intents are prioritized, and the intent with the highest priority is chosen as the best-guess hypothesis." See Column 11, Line 66 - Column 12, Line 2. Luciw further discloses that "in FIG. 6a a step 134 initializes a counter k to zero." See Column 12, Line 25. Luciw further discloses that "in FIG. 6b, step 132 receives the variable k, which is *the number of template matches and, therefore, the number of possible user intents*." See Column 12, Lines 54-56. As interpreted by the Applicants, the *number of possible user intents*, e.g., task types such as scheduling, filing, faxing, *are counted*. Counting the number of possible user intents is not establishing a *predictive list*. Neither does Luciw disclose *storing a predictive list and selecting a predictive default entry from the predictive list based on a predetermined algorithm*.

Luciw does not disclose "selecting a data entry from the predictive list based upon a user selected *weighted determination of the recency and frequency of use of listed data entries*" as recited in claims 45, 57 and 69. Luciw discloses "a heuristic procedure might guess that the person is the person most frequently called out of the last ten persons called. Alternatively, the heuristic procedure may make the simple guess that PERSON was the last person mentioned by the user in another context." See Column 14, Lines 41-46. Luciw does not disclose using a *weighted determination of both the recency and frequency of use of listed data entries*.

Luciw does not disclose "*capturing user entries of data into the defined field and storing captured entries in the predictive list*" as recited in claims 47, 59 and 71. Luciw discloses that "as the CPU *senses the position and movement of the stylus*, it *generates a corresponding image on the screen* to create the illusion that the stylus is drawing the image directly upon the screen, i.e. that the stylus is 'inking' an image on the screen. With suitable recognition software, text and numeric information can also be entered into the pen-based computer system in a similar fashion." See Column 2, Lines 28-34. As interpreted by the Applicants, Luciw simply discloses a computer system that allows the user to input information and generate images on the screen via a stylus. Luciw does

not disclose *capturing user entries of data into the defined field* and *storing captured entries in the predictive list*."

II. REJECTIONS UNDER 35 U.S.C. §103(a):

The Office Action has rejected claims 37-72 under 35 U.S.C. §103(a) as being unpatentable over Capps (U.S. Patent No. 5,66,502) in view of Dipaolo et al. (U.S. Patent No. 5,367,619) (hereinafter "Dipaolo"). The Office Action has further rejected claims 46, 58 and 70 under 35 U.S.C. §103(a) as being unpatentable over Luciw. Applicants respectfully traverse the rejections and respectfully request that the Examiner reconsider and withdraw all outstanding rejections.

Applicants hereby incorporate the arguments stated in the above section entitled "REJECTIONS UNDER 35 U.S.C. §102(b)."

*A prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. See M.P.E.P. §2142. The motivation or suggestion to combine references must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The showings must be clear and particular. See *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

In order to reject under 35 U.S.C. §103, therefore, the Examiner must provide a proper motivation for combining or modifying the references. See M.P.E.P. §2142; *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998). The Examiner recites that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Dipaolo's teaching of automatic filling a data field to Capps for filling the data field with the most possible data entry from the list. Motivation of the combining is for the advantage of automatic filling of the data field without action by the user." See Office Action, Page 4.

There is no motivation to combine Capps with Dipaolo as there is no suggestion or motivation in Capps to ease the filling of data fields by *automatic filling* when fields have only *one valid data entry* and therefore one of ordinary skill would not be motivated to combine the references. Capps teaches that "the *historical list contains the most recently and/or frequently used data values* for the data field that the user is inputting data. Preferably, the *historical list is displayed over a form* also being displayed that requires the data input into its one or more of its fields. *By using the historical lists a user is able to enter data with a greater ease of use than previously obtainable.*" See abstract. Capps further teaches that "in any case, when the user seeks to enter data into the name field 184, the *user can click, tap or otherwise select the history list indicator 186 to obtain the history list for names.* Preferably, each history list is associated with a field class. The input fields of a form then designate the field class associated therewith." See Column 10, Lines 60-66. Dipaolo teaches that "fields which have only *one valid data entry* which is dependent upon entries made for designated other fields may be *designated automatically.*" See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to *those fields with only one defined data entry.* That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry.* As interpreted by the Applicants, the purpose of having a *historical list is to provide a list of a plurality of valid data entries* the user may select. There is not just one valid entry. Therefore, there is no motivation to combine Capps with Dipaolo as there would be no automatic filling because the fields have more than one valid entry.

Capps and Dipaolo, taken singly and in combination, do not teach or suggest "exercising a *predictive widget to supply a data entry* for a defined data field" as recited in claims 37, 49 and 61. Dipaolo teaches that "*fields which have only one valid data entry* which is dependent upon entries made for designated other fields *may be designated automatically.*" See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to *those fields with only one defined data entry.* That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry.* When there can only

be one valid entry in the data field, there is *nothing predictive* about what the entry of that specific data field should be.

Capps and Dipaolo, taken singly and in combination, do not teach or suggest *"exercising a predictive widget to supply one of a predictive default and a predictive fill selected from the predictive list as a data entry for the defined data field"* as recited in claims 48, 60 and 72. Capps teaches that *"the historical list contains the most recently and/or frequently used data values for the data field that the user is inputting data."* See abstract. Dipaolo teaches that *"fields which have only one valid data entry which is dependent upon entries made for designated other fields may be designated automatically."* See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to *those fields with only one defined data entry*. That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry*. As interpreted by the Applicants, a control program implementing Dipaolo's automatic filling feature would not be able to *supply a predictive default and a predictive fill selected from the predictive list* as a data entry for the defined data field because the data field has more than one valid data entry with which the program selects from the predictive list. That is, the control program supplies an entry from the predictive list that *most likely* will be selected by the user but may not be the entry the user would have selected.

For at least the above reasons, claims 37, 48, 49, 60, 61 and 72 are patentable over Capps in view of Dipaolo and patentable over Luciw. Claims 38-47, 50-59 and 62-71 each recite combinations of features including the above combinations, and thus are patentable for at least the above reasons as well. Claims 38-47, 50-59 and 62-71 recite additional features which, in combination with the features of the claims upon which they depend, are patentable over Capps in view of Dipaolo and patentable over Luciw.

Capps and Dipaolo, taken singly and in combination, do not teach or suggest that *"when the control program is executing on the processor, in storing a predictive list and selecting a predictive default entry from the predictive list based on a predetermined algorithm"* as recited in claims 39, 51 and 63 and similarly in claims 40, 41, 42, 52, 53, 54, 64, 65 and 66. Capps teaches that *"the historical list contains the most recently and/or frequently used data values for the data field that*

the user is inputting data." See abstract. Capps further teaches that "in any case, when the user seeks to enter data into the name field 184, the user can click, tap or otherwise *select the history list indicator 186 to obtain the history list for names*. Preferably, each history list is associated with a field class. The input fields of a form then designate the field class associated therewith. See Column 10, Lines 60-66. Dipaolo teaches that "*fields which have only one valid data entry* which is dependent upon entries made for designated other fields *may be designated automatically*." See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to *those fields with only one defined data entry*. That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry*. As interpreted by the Applicants, a control program implementing Dipaolo's automatic filling feature would not be able to *select a predictive default entry from a predictive list* based on a predetermined algorithm because the data field has more than one valid data entry with which the program selects from the predictive list. That is, the control program selects an entry from the predictive list that *most likely* will be selected by the user but may not be the entry the user would have selected. Hence there is more than one valid entry.

Capps and Dipaolo, taken singly and in combination, do not teach or suggest that "when the computer program is executing on the processor, in *selecting a data entry from the predictive list based upon the recency of use of listed data entries*" as recited in claims 43, 55 and 67. Capps and Dipaolo, taken singly and in combination, do not teach or suggest that "when the computer program is executing on the processor, in *selecting a data entry from the predictive list based upon the frequency of use of listed data entries*" as recited in claims 44, 56 and 68. Capps and Dipaolo, taken singly and in combination, do not teach or suggest that "when the computer program is executing on the processor, in *selecting a data entry from the predictive list based upon a user selected weighted determination of the recency and frequency of use of listed data entries*" as recited in claims 45, 57 and 69. Capps teaches that "the history list 200 is the history list associated with the field class 'full name' and includes five (5) names of persons that were most recently and/or frequently used on the computer system." See Column 11, Lines 3-7. As interpreted by the Applicants, Capps simply teaches a history list with entries that were most recently and/or frequently used *but not a*

*program selecting an entry from a predictive list based upon recency, frequency or a user selected weighted determination of the recency and frequency of use of the listed data entries.* Dipaolo teaches that *"fields which have only one valid data entry which is dependent upon entries made for designated other fields may be designated automatically."* See Column 2, Lines 50-53. As interpreted by the Applicants, Dipaolo specifically limits automatic filling of fields to *those fields with only one defined data entry.* That is, as interpreted by the Applicants, Dipaolo automatically enters the data of a specific data field *when there can only be one valid entry.* As interpreted by the Applicants, a control program implementing Dipaolo's automatic filling feature would not be able to *select a data entry from the predictive list based upon the recency or frequency of use or based upon a user selected weighted determination* because the data field has more than one valid data entry with which the program selects from the predictive list. That is, the control program selects an entry from the predictive list that *most likely* will be selected by the user but may not be the entry the user would have selected.

Capps, Dipaolo and Luciw, taken singly and in combination, do not teach or suggest that "storing the predictive list as a sequence of possible data entries and in ordering the sequence by positioning *a leading portion of the sequence based on the recency of use of listed data entries and a trailing portion of the sequence based on the frequency of use of listed data entries*" as recited in claims 46, 58 and 70. Capps teaches that "in this example, the name 'Diane Penn' was displayed before the name 'Steve Smith' because it was the *most recently used item* within the table 202 and the *relative difference in the frequencies of usage were not substantial enough to list them in the opposite order.*" See Column 11, Lines 47-51. Furthermore, Capps teaches that "lastly, the name 'Mary Kay' is placed in the history list 200 because within the history table 202, the name '*Mary Kay*' was *last in time* and its frequency is not substantially greater than other entries." See Column 11, Lines 58-61. As interpreted by the Applicants, the history list in Capps lists the order of names according to recency where the name in the top of the list is the most recent and the name on the bottom of the list is the least recent. Capps does not teach a *trailing portion of the sequence based on the frequency of use.* Furthermore, as interpreted by the Applicants, 'Steve Smith' would be placed before 'Diane Penn' if the frequency of usage of 'Steve Smith' was substantially greater than



the frequency of usage of 'Diane Penn.' Therefore, Capps does not teach a *leading portion of the sequence based on the recency of use of listed data entries*. The Office Action states that Luciw fails to "clearly teach that the giving more weight to the recency of usage such that the list comprises a leading portion based on the recency of use and a trailing portion based on frequency of use." See Office Action, Page 8. The Office Action further states that "giving more weight to the recency of usage would have been an obvious design preference." See Office Action, Page 8. Applicants respectfully contest the Office Action's assertion that it would have been obvious to give more weight to the recency of usage. Applicants respectfully request a reference that supports the Office Action's assertion pursuant to M.P.E.P. §2144.03.

As a result of the foregoing, Applicants respectfully assert that the Examiner's prima facie case of obviousness is not taught or suggested by the cited prior art since there are numerous claim limitations, and thus one skilled in the art would not have been able to create the claimed invention in view of the cited prior art.

### III. NON-STATUTORY DOUBLE PATENTING REJECTIONS:

The Office Action has rejected claims 37-72 under the judiciary created doctrine of non-statutory double patenting as being unpatentable over Bertram et al. (U.S. Patent No. 5,864,340), Bertram et al. (U.S. Patent No. 5,805,159) and Bertram et al. (U.S. Patent No. 5,805,158).

While Applicants respectfully traverse this rejection as to at least some of the claims, to expedite prosecution of the present application, Applicants submit herewith a terminal disclaimer to overcome these rejections. Applicants note that filing of a terminal disclaimer is not an admission of the propriety of the non-statutory double patenting rejection. See M.P.E.P. § 804.02.

### IV. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining Claims in the Application are in condition for allowance, and respectfully request an early allowance of such Claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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